

Atty. Docket No. CH919990043
(590.041)

REMARKS

The fact that December 24, 2005, fell on a Saturday and Monday, December 26, 2005, was a Federal Holiday ensures that this paper is timely filed as of December 27, 2005, the next business day.

In the Office Action dated October 24, 2005, pending Claims 1-16 were rejected and the rejection made final. Of these claims, Claims 1, 10, 12, 15, and 16 are independent claims; the remaining claims are dependent claims. All claims stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ferstenberg et al. in view of Applicants' alleged admissions. The Office is respectfully requested to reconsider the rejections presented in the outstanding Office Action in light of the following remarks.

The comments made in the previous Amendments are equally applicable here, however, in the interest of brevity they are not repeated but merely incorporated by reference. In responding to these comments, however, the Office states in the outstanding Office Action,

The Examiner recognizes the bidirectional quality of the claimed CORBA structure as disclosed in the background of the specification. However, these characteristics are not clearly brought out in the claim language. As such, with regard to the Applicant's assertions that the prior art of record does not fairly teach or disclose each and every limitation contained within the claims, it appears as if the Applicant is reading limitations into the claims from the specification. Consequently, the points argued are not recited in the claims themselves. For that reason, a solid argument in their contemplation cannot be established. Subsequent amendments to the claim language that would include the positions presented by the Applicant's arguments would provoke the Examiner to address the claims individually and as a whole, in light of the remaining limitations as well as the

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specification. Until such amendments are rendered, the arguments are disregarded and will not be countered.

(*Office Action* at 2). Applicant assumes this language refers to the "bi-directional" nature of the present invention. A review of the independent claims, however, shows that such limitations are currently present.

While the following discussion is in reference to independent Claim 1, it is equally applicable to all of the independent claims as similar language appears therein.

Claim 1 is reproduced below for the convenience of the Office:

1. A method for determining, in a trader device of an electronic trading system, whether a match exists between a client requirement, provided by a client device of the system, and a supplier offer stored in said trader device, the supplier offer comprising feature data, indicative of a set of features of an offered product, including at least one updatable feature data element which is indicative of a variable feature of the offered product and includes address data indicative of a location from which a current specification of the variable feature can be obtained by the trader device in response to an update request from the trader device, the method comprising:

- a) receiving from the client device a client requirement comprising constraint data in standard CORBA constraint language, indicative of a set of required product features, and at least one updatable feature data element, indicative of a variable required product feature, which includes address data indicative of a location from which a current specification of the variable feature can be obtained by the trader device in response to an update request from the trader device;
- b) comparing the constraint data and the feature data;
- c) repeatedly issuing update requests to obtain current specifications for said updatable feature data elements of the supplier offer and the client requirement and determining whether a negotiation success condition, dependent on said current specifications, is satisfied, until said negotiation success condition or a negotiation termination condition is satisfied; and

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d) determining that a match exists between the client requirement and the supplier offer if said feature data corresponds to said constraint data and said negotiation success condition is satisfied.

(emphasis added)

The emphasized portions of the claim language illustrate the novel bi-directional nature of the present invention, and contrary to the statements made in the outstanding *Office Action* this characteristic is brought out in the claim language. Since in the present invention, as indicated above, both the supplier and the client have updateable data, i.e., product feature data (see Preamble) and required product feature data (see element a), the applied art does not anticipate, teach, or suggest the present invention. As previously discussed, the bi-directional process of the present invention differs from the one-way process used in the CORBA trading service described in the Specification where a match is identified "based on comparison of constraint data supplied by the clients with feature data describing products offered by suppliers." (See Page 3, line 18 - Page 4, line 3). Thus, contrary to the statements made by the Office, the points argued in the prior Amendment are recited in the claims and thus, the arguments made in the prior Amendment should be considered.

The Office also states that it is "troublesome" that Applicant appears to be ignoring the Ferstenberg reference with regard to the bi-directional nature of the electronic negotiation allegedly disclosed by Ferstenberg. (*Office Action* at 3) Applicant respectfully submits he is not ignoring Ferstenberg as prior responses include a detailed discussion of Ferstenberg. Furthermore, as discussed in previous responses, Ferstenberg does not teach an exchange process using the CORBA language having the same

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elements as the present invention. Additionally As stated in the prior response, “[i]t is clear that the underlying purposes between the claimed invention and Ferstenberg et al. are different, which, in turn, has resulted in the processes themselves being substantially different, which in turn has required the use of substantially different elements to create and use the processes.” (Page 18)

The Office also notes that it appears “as if the Applicant is attacking the references in a piecewise fashion, instead of in combination, as intended by the Examiner ...” (*Office Action* at 3) While the outstanding rejection is based on the combination of Ferstenberg et al. in view of Applicants’ alleged admissions , it is appropriate to individually consider the teaching of each item used in the combination. Nearly twenty years ago, the Court of Appeals for the Federal Circuit recognized the importance of the individual references in characterizing the holding of *In re Imperato*, 179 USPQ 730 (C.C.P.A. 1973), as follows:

The lesson of this case appears to be that prior art referenced in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings.

Again, in *ACS Hospital Systems, Inc. v. Montifore Hospital*, 221 USPQ 929 (Fed. Cir. 1984), the Court stated:

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of reference can be combined **only** if there is some suggestion or incentive to do so. The prior art of record fails to provide any such suggestion or incentive. Accordingly, we hold the Court below erred as a matter of law in

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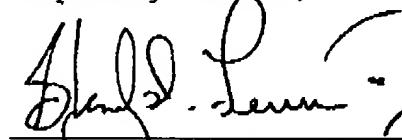
concluding the claimed invention would have been obvious to one of ordinary skill in the art under section 103.

These Federal Circuit teachings are especially cogent here given the combination of Ferstenberg et al. and Applicants' alleged admissions fails to teach or suggest the instantly claimed invention.

In view of the foregoing, it is respectfully submitted that Claims 1, 10, 12, 15 and 16 are fully distinguishable over the applied art and are thus allowable. By virtue of dependence from these claims, it is thus also submitted that Claims 2-9, 11 and 13-14 are also allowable at this juncture. Accordingly, it is respectfully submitted that the instant application, including Claims 1-16, is presently in condition for allowance. Notice to the effect is hereby earnestly solicited.

If there are any further issues in this application, the Examiner is requested to contact the undersigned at the telephone number listed below prior to the issuance of an Advisory Action.

Respectfully submitted,



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